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ART UNIT 2617 571-273-8300  
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RE: APPLICATION NO. 10/617,074

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Matthew J. Appino

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5	APPLICANT: PREECE	EXAMINER: Cumming
	SERIAL NO.: 10/617,074	GROUP: 2617
	FILED: July 10, 2003	CASE NO.: CS22227RA
10	ENTITLED: OBTAINING SERVICE WHEN IN A NO-COVERAGE AREA OF A COMMUNICATION SYSTEM	

15 Motorola, Inc.  
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20 **APPEAL REPLY BRIEF**

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Atty. Docket No. CS22227RA

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**I. REAL PARTY IN INTEREST**

The Examiner's Answer correctly acknowledges the real party in interest.

5

**II. RELATED APPEALS AND INTERFERENCES**

The Examiner's Answer correctly acknowledges the related appeals or interferences.

10

**III. STATUS OF CLAIMS**

The Examiner's Answer correctly indicates claims 1-8 and 15-26 are pending, of which claims 1-8 and 15-20 are rejected and claims 21-26 are allowed.

15

**IV. STATUS OF AMENDMENTS**

The Examiner's Answer correctly acknowledges the status of Amendments After Final Rejection.

20

**V. SUMMARY OF CLAIMED SUBJECT MATTER**

The Examiner's Answer correctly acknowledges the summary of the claimed subject matter.

25

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Examiner's Answer correctly acknowledges the grounds of rejection to be reviewed on Appeal.

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## VII. ARGUMENT

### Claim Limitations At Issue

5

In Claim 1, the limitations at issue are italicized below:

1. A method for obtaining service when in a no-coverage area of a radiotelephone communication system, the method comprising the steps of:
- 10 storing information regarding a last known available communication system;  
reporting the information about the last known available communication system to a user of the radiotelephone; and  
15 *using the information to obtain service from the last known available communication system.*

In Claim 15, the limitations at issue are italicized below:

15. A mobile radiotelephone operable to obtain service when in a no-coverage area of a communication network, the radiotelephone comprising:
- 20 a user interface;  
a memory;  
a processor coupled to the user interface and the memory, the processor controls radio communication circuitry for communication with the communication network, wherein the processor stores information regarding the last known available service from the communication network in the memory and reports this information to a user of the radiotelephone through the user interface when the radiotelephone is in a no-coverage area, such that the user can use this information to obtain service from the last known available communication network.
- 25

30 Applicants' Argument

Applicant maintains the claims expressly recite a method performed while in a no-coverage area. More particularly, none of the claims recite obtaining service while a radio

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telephone is "still" in a no-coverage area. The elements of the method are used to obtain service. Furthermore, contrary to the Examiner's Answer's allegations, there is no recitation of a step of actually obtaining service in the no-coverage area. Again, the preamble expressly recites the method is performed while in a no-coverage area. To elaborate, the method recites steps performed in the no-coverage area that can be used to obtain service from the last known available communication network. There is no claimed step of actually obtaining service when the radiotelephone is still in the no-coverage area.

In the "Response to Argument" section, the Examiner's Answer alleges "Appellant totally intently ignores and scoffs at *In re Mayhew* which states a feature which is taught as critical in a specification, the radiotelephone moving into a radiotelephone service area to obtain service, and is not recited in the claims should result in a rejection of the claim under the enablement provision of 35 U.S.C. § 112." With all due respect to *In re Mayhew*, Applicant disagrees. In fact, Applicant does not "ignore" *In re Mayhew* because applicant does not teach the radiotelephone moving into a radiotelephone service area to obtain service" as critical in the specification. In particular, according to the U.S. Patent and Trademark Office's own interpretation of *In re Mayhew*, "an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended." (MPEP § 2164.08(c)) In abiding with *In re Mayhew*, the specification does not make it clear that any limitation is "critical" for the invention to function as intended. This is supported by the fact that the Examiner's Answer itself does not even support its allegation by citing the specification. Thus, Applicant does not "ignore" *In re Mayhew* because Applicant does not teach "the radiotelephone moving into a radiotelephone service area to obtain service" as critical in the specification. In fact, *In re Mayhew* actually supports the impropriety of a rejection of the claims under the enablement requirement.

The Examiner's Answer goes on to discuss the "written description" requirement. However, Applicants assert none of the Office Actions or the Examiner's Answer have properly complied with MPEP § 2164.03. In particular, the Office Actions did not satisfy "the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." The Examiner's Answer and the Office Actions did not "set forth express findings of fact which support the lack of written description conclusion." No express findings of fact were ever presented in the Office Actions to establish a *prima facie* case.

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5 The Examiner's Answer only makes an allegation of "The specification inadequately describes the location system independent of the communication system as stated by claim 5 and the location broadcasting network access points as stated by claim 8. These items are not discloses [sic] where they even are." However, this is an insufficient allegation to support a rejection based on the written description requirement. In particular, as previously asserted, "There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed" (MPEP § 2163). Applicant even provided support in Applicant's Appeal Brief by referencing page 7, lines 5-8 page 8, lines 22-29 of the specification. However, the Examiner's Answer does not attempt to address this support.

10 Thus, the claims are supported by the specification and the Examiner's Answer does not overcome the "strong presumption that an adequate written description of the claimed invention is present in the specification as filed" *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976).

15 Accordingly, Applicant requests the withdrawal of the rejection of claims 5 and 8 under 35 U.S.C. § 112 first paragraph.

In discussing the rejection under 35 U.S.C. § 112, second paragraph and in following MPEP § 2173.03, the Examiner's Answer states "no claim may be read apart from and independent of the supporting disclosure on which it is based." This supports the facts that the claims are clear and definite. In particular, contrary to both MPEP § 2111 and 2173.03, the

20 Examiner's Answer appears to make an unreasonable interpretation of the claim, especially when considering the supporting disclosure and the level of one of ordinary skill in the art. For example, the Examiner's Answer alleges "the claims contradict its self [sic]. These claims are confusing since obtaining service from a no-coverage area of a radiotelephone communication system [sic]. By definition a no coverage area does not have any service. If

25 the radiotelephone can receive service, by definition, it cannot be a no-service area." This interpretation is unreasonable because Applicant never claims receiving service in a no-service area. Applicant only claims a method that is performed while in a no-coverage area. The claims expressly state the method allows for obtaining "service from the last known available communication system," not from the no-coverage area. Furthermore, the disclosure clearly

30 illustrates the claimed method is performed in a no-coverage area to allow for obtaining service from the last known available communication system. Thus, not only is the Examiner's Answer reading the claims independent of the supporting disclosure, the

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Examiner's Answer is also reading the preamble of the claims independent of the claim elements themselves.

Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

5 In discussing the rejection under 35 U.S.C. §101 for being inoperative and lacking utility, the Examiner's Answer reiterates "it is impossible to obtain service from a no-coverage area of a radiotelephone communication system since inherently a no-coverage area does not have any service." Again, as discussed above, the claims are operative and have utility by being a method performed while in a no-coverage area that provides information for obtaining  
10 service from the last known available communication system. The claims expressly state the method is used to obtain service not from the no-coverage area, but from the last known available communication system. There is no recitation of a step of actually obtaining service in the no-coverage area. The method recites steps performed in the no-coverage area that can be used to obtain service from the last known available communication system. Therefore, the  
15 claims are operative and have utility.

Accordingly, Applicant requests the withdrawal of the rejection under 35 U.S.C. §101.

#### CONCLUSION

20 In view of the discussion above, the claims of the present application are in condition for allowance. Kindly withdraw any rejections and objections and allow this application to issue as a United States Patent without further delay.



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The Commissioner is hereby authorized to deduct any fees arising as a result of this Reply Brief or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

5

Respectfully submitted,



10

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15

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